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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,922	09/19/2001	Eric R. Melzer	M895 .12-0001	9710

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EXAMINER

FRANCIS, FAYE

ART UNIT PAPER NUMBER

3712

10

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicant(s)

09/955,922

Examiner

Faye Francis

Applicant(s)

MELZER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5 and 11-20 is/are allowed.
- 6) ☒ Claim(s) 1,2,6-10 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the teaching that no more than one of the plurality of appendages is pivotally connected to the torso at each articulation point, as now recited in claim 21. No new matter should be entered into the application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 21 is finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New Matter.

The specification as originally filed does not provide support for the teaching of "wherein no more than one of the plurality of appendages is pivotally connected to the torso at each articulation point" as now recited in claim 21.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 6-10 and 21 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Wion.

Smith discloses in Figs 1-6, a character object [doll 16] comprising an artistic layer [paper applique 20], at least one magnet [magnetic body 18] as recited in claim 1.

Smith does not disclose articulation points, pivotal connection, the first and second leg members have at least two articulated members as recited in claim 6, the character object having third and fourth leg members as recited in claim 7, the first and second arm members have at least two articulated segments as recited in claim 8 and a head member as recited in claim 10.

Wion teaches the concept of providing an articulated figure having a plurality of articulation points [Figs 1 and 2], a plurality of appendages pivotally connected to the torso and the first and second leg members have at least two articulated members 16, 17, 19 and 20, a head member 1 and the first and second arm members have at least two articulated segments. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Smith with the missing elements as taught by Wion in order to enable the figure to be held in any one of a wide variety of desired positions making the toy more fun to play with.

With respect to the character object having third and fourth leg members, Wion reference further recognizes that the character object may also represent an animated object such as a dog [col 3 line 22]. It would have been obvious to provide the device of Smith with the third and fourth leg members as suggested by Wion in order to represent animals such as a dog, a cat or a horse making the toy more fun to play with.

***Allowable Subject Matter***

6. Claims 3-5 and 11-20 are allowed.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's main argument in page 10, that the rejection of claim 1 under U.S.C. § 103 should be withdrawn because the proposed modification by the examiner would destroy the secondary reference, the examiner would like to point out that both Smith and Wion references are concerned to provide a figure made out of planner sheet of magnetic material in order that a surface to surface contact can be achieved between the figurine and a metallic surface. In addition, the Wion reference teaches that the figure can be articulated. Therefore, the combined teachings of the references would have suggested to those of ordinary skill in the art without destroying the secondary reference.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

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Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The question under 35 USC §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). In this case, the artisan would have been motivated to provide the device of Smith with the missing elements in order to enable the figure to be held in any one of a wide variety of desired positions making the toy more fun to play with and to provide the device of Smith with the third and fourth leg members in order to represent animals such as a dog, a cat or a horse making the toy more fun to play with.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper **hindsight** reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

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not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, one of the ordinary skill in the art taking into account only knowledge which was within the level of his/her ordinary skill at the time the claimed invention was made, and without including knowledge gleaned only from the applicant's disclosure would have been motivated to further modify the device of Smith as stated above.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

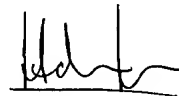
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

FF

A handwritten signature in black ink, appearing to be "H. Banks", written over a horizontal line.